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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,768	10/14/2003	John F. Otte	6683.76US01	6334
43541 7590 02/06/2007 WOOD, HERRON & EVANS (ZIMMER SPINE) 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT	PAPER NUMBER
			3733	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/685,768

Applicant(s)

OTTE ET AL.

Examiner

Nicholas Woodall

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 05/07/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Invention III in the reply filed on 11/06/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election ***without traverse*** (MPEP § 818.03(a)).

Claims 1-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made ***without traverse*** in reply filed on 11/06/2006.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

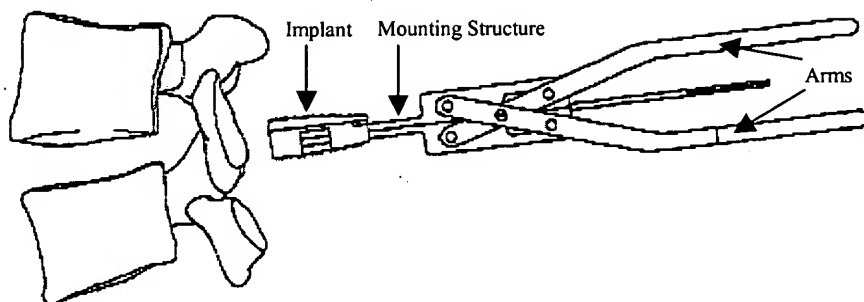
The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 3733

3. Claim 51 is rejected under 35 U.S.C. 102(e) as being anticipated by Gerbec (U.S. Patent 6,648,917 B2).

Regarding claim 51, discloses a device comprising a scissor arrangement including a first arm connected to a second arm at a pivot location between a proximal end and a distal end (see Figure 1 below). The device further comprises a mounting structure located at the distal end of the scissor arrangement. The mounting structure is defined by shaped tips of the first and second arms and is configured to insert within an opening of an implant wherein the tips are capable of grasping the implant from within the opening of the implant. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Gerbec, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Figure 1

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 52 and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trieu (U.S. Publication 2004/0133280) in view of Michelson (U.S. Patent 6,139,551).

Regarding claim 52, Trieu discloses a kit of devices comprising an expandable implant and an insertion tool that is capable of expanding the implant once placed into a patient. Trieu further discloses a mounting device adjacent the distal end of the instrument, wherein the definition of end is "a part or place at or adjacent to an extremity" ([www.dictionary.com](http://www.dictionary.com)), when compressed and wherein the mounting device is at the distal end of the instrument when fully actuated. Trieu further discloses the use of a chisel for preparing the vertebrae prior to inserting the implant into the patient (paragraph 078). Regarding claim 56, Trieu further discloses the first instrument further

includes a first member and a second member that move in opposite directions to expand the implant. Regarding claims 57-59, Trieu further discloses the implant to include a locking mechanism (reference numbers 634 and 644) to keep the implant in an expanded position. Trieu fails to disclose a second instrument for use in a revision process to remove the implant. Michelson teaches a revision process wherein a revision instrument is used in order to remove a failed implant from a patient (column 2 lines 14-25). The type of revision instrument would depend on the type of implant the surgeon was placing inside a patient, and a revision instrument to be used with an expandable implant would inherently have to be capable of unlocking and collapsing the implant prior to removal of the implant. Therefore, Michelson teaches the concept of providing a revision instrument for the removal of an expandable implant that would inherently be capable of unlocking and collapsing the implant prior to removing the implant from the patient. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the kit of Trieu with a revision instrument in view of Michelson in order to remove a failed implant from a patient.

6. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trieu (U.S. Publication 2004/0133280) in view of Michelson (U.S. Patent 6,139,551) further in view of Martz (U.S. Publication 20058/0251146).

Regarding claim 53, the combination of Trieu and Michelson discloses the invention as claimed except for the kit to further comprise a second chisel (claim 53). Martz teaches a procedure wherein a second chisel is used separately from a first chisel in order to smooth and finish the channels created by the first chisel (paragraph

Art Unit: 3733

123). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the kit of Trieu modified by Michelson with a second chisel in view of Martz in order to smooth and finish the channels created by the first chisel.

7. Claims 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trieu (U.S. Publication 2004/0133280) in view of Michelson (U.S. Patent 6,139,551) further in view of Martz (U.S. Publication 20058/0251146) further in view of Brown (U.S. Patent 5,919,007).

Regarding claims 54 and 55, the combination of Trieu, Michelson, and Martz discloses the invention as claimed except for the first chisel to include teeth and the second chisel to include a rough surface, the examiner believes a rough surface is anything that is not smooth such as serrations or teeth. Brown teaches adding teeth to the surface of a chisel in order provide a smoother finish (column 2 lines 6-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the kit of Trieu modified by Michelson further modified by Martz with chisel including teeth in view of Brown in order to provide a smoother finish.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER